

## **REMARKS**

Claims 1-9 and 11-20 are pending in the instant application. Claim 10 was cancelled in a previous Amendment. No claims are added, cancelled, or amended in the instant Response.

### **Claims Rejected as Obvious Over Woerner In View of Cornelius:**

Claims 1-9 and 11-20 stand rejected under 35 U.S.C. §103 as being unpatentable over Woerner et al. (U.S. Pat. No. 6,737,458) in view of Cornelius et al. (U.S. Pat. No. 4,677,141). The Applicant once again respectfully disagrees with this combination and asserts that the '458 and '141 patents expressly teach away from this instant invention and thus fail to render this invention obvious. The Applicant also respectfully asserts that even upon combination of these references, there still is no reasonable expectation of success in arriving at the instant invention.  
In support of these assertions, the Applicant has concurrently filed a Declaration Under 37 C.F.R. § 1.132 from a person of high skill in the art of silicone rubber development and formulation.

### **Teaching Away From The Instant Invention:**

First and foremost, both the '458 and '141 patents teach away from the instant invention because each requires the use of *reinforcing* fillers to form silicone elastomers with sufficient physical and mechanical strength. The instant invention, on the other hand, is specifically claimed as free of reinforcing fillers. Thus, these references are not obviously or predictably combinable and fail to render this invention obvious. The Applicant realizes that the Examiner disagrees with this assertion but respectfully requests that the Examiner review the concurrently filed Declaration to better understand the Applicant's reasoning based on the opinion of one of high skill in the art of silicone rubber development.

The '458 Patent:

The Applicant appreciates the Examiner's argument<sup>1</sup> that Col. 6 of the '458 patent uses the word "if" in the context of "if the silicone compositions comprise actively reinforcing fillers..." The Applicant also appreciates the Examiner's conclusion that, based this language, reinforcing fillers are not required in the '458 patent.

However, the Applicant respectfully disagrees with the Examiner's conclusion and submits that the teachings and utility of the '458 patent cannot be boiled down to a single sentence. Instead, the '458 patent must be considered "*as a whole*" including portions that would lead away from the claimed invention.<sup>2</sup> Here, the stated goal and focus of the '458 patent is to form silicone elastomers<sup>3</sup>. As explained in the concurrently filed Declaration, reinforcing fillers are required to form a useable silicone elastomer. Accordingly, the Examiner cannot interpret the '458 patent in a way that would destroy its utility (i.e., destroy the silicone elastomer) or change its mode of operation (i.e., a way that the silicone elastomer is formed), when considering the '458 patent *as a whole*.<sup>4</sup>

More specifically, the '458 patent must utilize reinforcing fillers even if the one sentence cited by the Examiner is written in such a way that reinforcing fillers "appear" to be optional. "As a whole," the utility of the '458 patent hinges on forming silicone elastomers which requires the use of reinforcing fillers. This utility cannot be destroyed by the Examiner when making an obviousness rejection. Thus, since the '458 patent requires the use of reinforcing fillers, and the instant invention is free of these same fillers, the Applicant respectfully asserts that the '458 patent cannot be used to render the instant claims obvious.

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<sup>1</sup> See Page 2 of the Advisory Action dated February 5, 2009

<sup>2</sup> See MPEP §2141.02

<sup>3</sup> See at least the abstract, summary, and claims of the '458 patent

<sup>4</sup> See MPEP §2143.01

The ‘141 Patent:

The Applicant also appreciates the Examiner’s argument<sup>5</sup> that “[t]he fact that ‘141 includes reinforcing fillers to obtain specific properties does not take away from any *expectation* of using the clay disclosed therein to obtain the *known* benefits and properties associated therewith, as per the *teachings* in ‘141” (emphasis added). However, the Applicant again respectfully disagrees.

As set forth and further described in the concurrently filed Declaration, the ‘141 patent uses white clay merely as a heat stability additive without any explanation or acknowledgement of any reinforcing effect whatsoever. Accordingly, there is no “expectation” of any “known” benefits based on any “teachings” of the ‘141 patent, as suggested by the Examiner. The ‘141 patent is silent as to the benefits of the white clay that are realized in the instant invention. Thus, it is inaccurate to suggest that one of skill in the art would obviously or predictably combine the ‘141 patent with the ‘458 patent to form the instant invention and achieve its same results.

No Reasonable Expectation of Success:

The Applicant also respectfully submits that even if the ‘458 and ‘141 patents are combined, there still is no reasonable expectation of success in arriving at the instant invention. In fact, and as set forth in the Declaration, relying on the ‘141 patent would be detrimental.

The technology of the ‘141 patent was specifically avoided when developing the instant invention. Said differently, the instant invention was explicitly intended to be an improvement of the ‘141 patent and its deficiencies. The ‘141 patent requires the use of reinforcing fillers and utilizes heat to cause a chemical reaction between a “treating agent” and the surface of the reinforcing fillers. This is precisely what was designed around and improved upon by the instant

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<sup>5</sup> See Page 2 of the Advisory Action dated February 5, 2009

invention. Use of reinforcing fillers is undesirable for many reasons including cost and processing considerations, as further described in the Declaration. The instant invention improves cost and processing considerations and greatly minimizes the deficiencies of the '141 patent by forming an entirely different type of composition that is free of reinforcing fillers.

Moreover, even if these references were combined, the "resultant" silicone composition would always include reinforcing fillers. A useable product simply could not be formed from these patents without the reinforcing fillers. This alone is enough to render the resultant silicone composition very different from the instant invention. In addition, the numerous deficiencies of these references would not be improved upon due to the use of the reinforcing fillers. In fact, there would likely be no difference between this "resultant" silicone composition and the many commercial compositions that are currently available. In other words, the resultant silicone composition would merely represent the current commercial products with all of their limitations and deficiencies, would fail to offer any improvement over the prior art whatsoever, and certainly would not be representative of the instant invention. Accordingly, the Applicant respectfully submits that it is inappropriate to combine the '458 and '141 patents and requests that all pending claim rejections be withdrawn.

### Conclusion

In view of the above arguments and the concurrently filed Declaration, the Applicant respectfully submits that the claim rejections under 35 U.S.C. §103 are overcome, and that all pending claims are both novel and non-obvious. Accordingly, the Applicant respectfully submits that all pending claims are in condition for allowance, and respectfully requests such allowance.

While it is believed that no additional fees are presently due, the Commissioner is authorized to charge the Deposit Account No. 08-2789, in the name of Howard & Howard

Attorneys PLLC, for any fees or credit the account for any overpayment.

Respectfully submitted,

**HOWARD & HOWARD ATTORNEYS PLLC**

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Date

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